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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,708	10/23/2003	Nigel Vicker	15469.0003	9747

27890 7590 03/26/2007  
STEPTOE & JOHNSON LLP  
1330 CONNECTICUT AVENUE, N.W.  
WASHINGTON, DC 20036

EXAMINER
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SHAMEEM, GOLAM M

ART UNIT	PAPER NUMBER
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1626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/690,708	VICKER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Golam M. M. Shameem, Ph.D.	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213..

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3,11,12,14-30,35-37,63 and 64 is/are pending in the application.
- 4a) Of the above claim(s) 16-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,11,12,14,15,26-30,35-37,63 and 64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/08/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

This application claims the benefit for foreign priority under 35 U.S.C. § 119(a)-(d) to United Kingdom 0224830.0 10/24/2002 is acknowledged

### ***Status of Claims***

Claims 1, 3, 11, 12, 14-30, 35-37, 63 and 64 are currently pending in the application. Claims 2, 4-10, 13, 31-34 and 38-62 have been canceled.

Receipt is acknowledged of amendment / response filed on January 11, 2007 and that has been entered.

Claims 16-25 are withdrawn from further consideration pursuant to 37 C.F.R. 1.142 (b) as being drawn to a non-elected subject matter.

### ***Information Disclosure Statement***

Receipt is acknowledged of Information Disclosure Statement (IDS), filed on 11/08/2006, which has been entered in the file.

### ***Response to Election/Restriction***

In response to the restriction requirement, Applicants have elected Group I, which includes claims 1, 3, 11, 12, 14, 15, 26-30, 35-37, 63 and 64 drawn to compounds and the elected species as set forth in compound STX470 (appearing on page 51 of the specification, Response page 1), is acknowledged. Because Applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election **without** traverse (MPEP § 818.03(a)). Therefore, the requirement for restriction is still deemed sound and proper.

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Applicants preserve their right to file a divisional on the non-elected subject matter.

As set forth in the restriction requirement and an election of a single compound (or set of compounds), the invention will encompass all compounds that fall within the scope of the claim is as follows:

A compound having the formula (IV) wherein:

R<sub>3</sub> is a hydrocarbyl,

L is absent,

R<sub>4</sub> is a hydrocarbyl,

R<sub>5</sub> is substituted aryl ring and

X is limited to S.

As a result of the election and the corresponding scope of the compound identified, claims 16-25 and the remaining subject matter of claims 1, 3, 11, 12, 14, 15, 26-30, 35-37, 63 and 64 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn subject matter of claims 16-25 is properly restricted as it differs materially in structure and in element from the elected subject matter supra so as to be patentably distinct there from.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 11, 12, 14, 15, 26-30, 35-37, 63 and 64 are rejected under 35 U.S.C. § 102(b) as being anticipated by Portnaya *et al* (1960). Applicant claims substituted heterocyclic compounds, and their methods of uses thereof. Portnaya *et al* also disclose the synthesis of several substituted benzothiazolyl derivatives and at least one of them anticipates the instantly claimed invention of formula IV, wherein, R<sub>3</sub> is a hydrocarbyl (such as Methyl), X is S [assuming X is S, applicant's elected compound], L is absent, R<sub>4</sub> is H, R<sub>5</sub> is optionally substituted aryl ring [STN International, HCAPLUS database, RN 93733-28-9, a copy is provided with this Office action], which reads on the instantly claimed compound.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claim in the subject matter, which the applicant regards as his invention.

Claims 1, 3, 11, 12, 14, 15, 26-30, 35-37, 63 and 64 are rejected under 35 USC § 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Formula (IV) recites the limitation of "X" but the definition of X is not disclosed anywhere (in fact X is deleted in amended claim 1) in claims 1, 3, 11, 12, 14, 15, 26-30, 35-37, 63 and 64 rendering the claims indefinite. The above expression is not defined in the claims so as to ascertain the metes and bounds of the claimed subject matter. The omission of failing to describe the claimed invention renders the claims incomplete. This rejection can be overcome through inserting the limitation of "X" or to amend the claims with in the context and scope of the claims in order to overcome the rejection. Appropriate correction is required.

***Objections***

Claims 1, 3, 11, 12, 14, 15, 26-30, 35-37, 63 and 64 are objected to for containing non-elected subject matter. The claims should be amended to exclude non-elected subject matter and within the scope of elected compound.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (571) 272-0706. The examiner can normally be reached on Tuesday-Thursday from 8:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (571) 272-0699. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (571)-273-8300.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality

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requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (571) 272-1600.

Golam M M Shameem, Ph.D.  
Primary Examiner  
Art Unit 1626  
Technology Center 1600

A handwritten signature in cursive script, appearing to read "G. M. Shameem", written in black ink.

**GOLAM M. M. SHAMEEM, PH.D.  
PRIMARY EXAMINER**

March 06, 2007